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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PARDO, THUY N	

ART UNIT	PAPER NUMBER
2168	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/692,314	KRANZ ET AL.	
	Examiner	Art Unit	
	Thuy N. Pardo	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2008 has been entered.

2. In Applicant's Amendment on February 28, 2008, claims 1-45 are pending in the application. Claims 1-6, 9-11, 14-21, 23, 24, 27-29, 32, 33, 35-39, 44 and 45 are amended. This Office Action is made Non-Final.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For instance, the contents of claims 1, 19, 33 and 45 are limited to abstract ideas, and do not constitute a statutory process, machine, manufacture or composition of matter in which the statutory process must result in a physical transformation. Federal courts have held that 35 U.S.C. Sec. 101 does have certain limited. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. Sec. 101, meaning that one may only

patent something that is a machine, manufacture, composition of matter or a process. See, e.g., Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556; In re Warmerdam, 33 F. 3d 1354, 1358, 31 USPQ2d 1754, 1757 (Fed. Cir. 1994). Applicant's claimed invention is not a combination of devices that appear to be directed to a machine and one or more steps of functions performed by the machine. There are no devices or machines found in the preambles or in the bodies of these claims. The limitation of "A tangibly-embodied computer-readable medium" recited in claim 19 is also non-statutory because computer-readable medium (or media) is not only limited to machines or devices such as a floppy disk, CD-ROM, magnetic disk, ROM, RAM, but also limited to a transmission medium, such as data signals (see page 18 of Specification). Since "computer-readable medium" is not a machine or device, it fails to fall within a statutory category of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 6-17, 19, 24-35 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii US Patent Application No. 2005/0021783, in view of Ishiguro US Patent No. 7,216,368.

As to claim 1, Ishii teaches the invention substantially as claimed, comprising:

receiving a content URL address for a content location on a server system at which a desired unit of digital content is stored [license stored in a storage unit in license server 4 of fig. 1; S47 of fig. 8; fig. 11, 12 and the content location on a server system, the content location having a content URL address, 0115-0116];

identifying licensing information address from the content URL address [0058; 0105; 0115-0116];

the licensing information address being different from then content URL address [URL link information on the license server including the license IDs inserted in HTML files of Web sites, e-mail, 0058; 0105 and the content server 3 is separate from the license server 4, see fig. 1], and

the licensing information address comprising an address to a licensing information location at which is stored licensing information from which licensed content URL addresses comprising addresses of locations of licensed units of digital content that the server system is authorized to provide to a client system [adding a digital signature to the license, see fig. 7; 0013; 0043; 0069];

using the licensing information address to access the licensing information at the licensing information location [allowing the user to perform the license acquisition by clicking to URL link information on the license server, 0105; 0108; the license server extracts the content to which the corresponding license can be applied and sends the client the content list including

content information, such as the content ID, the URL for downloading the content, and the genre of each piece of the extracted content [0115]; and

reviewing the content URL address and the licensing information to determine whether the content URL address comprises a licensed content URL address [S47-S50 of fig. 8; the license server determines whether the result of the authorization from the accounting server permits the grant of the license, 0109; s42-s47 of fig. 8; s104-s105 of fig. 12; signatures of license and content are valid, S47 of fig. 8; 0093].

However, Ishii does not explicitly teach using the licensing information address to access the licensing information although it has the same functionality of using the address of the license server for receiving the license [see fig. 7, 9 and 10]. Ishiguro teaches using the licensing information address to access the licensing information [see fig. 7 and 8; col. 10, lines 24-41].

Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add the feature of Ishiguro to the system of Ishii as an essential means to gains access to the license server through the communication unit and over the Internet.

As to claim 19, all limitations of this claim have been addressed in the analysis above, and this claim is rejected on that basis.

As to claims 33 and 45, they are apparatus claims of claims 1and 33; therefore, they are rejected under the same rationale.

As to claim 6, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches locating licensing information on the server by determining at least one potential location for the licensing information on the server based on the address of the content [S41-S49 of fig. 8].

As to claim 7, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the potential location determined for the licensing information is through a root directory on the server or through a subdirectory on the server where the content resides [0121].

As to claim 8, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches searching through the root directory for the licensing information [0055].

As to claim 9, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that if licensing information is not found through the root directory or if licensing information found through the root directory does not correspond to the content, further including searching through the subdirectory where the content resides on the server for the licensing information [0055; 0119-0123].

As to claim 10, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that obtaining licensing information is in response to a request, by a client system, to download the content from the server [S46-S47 of fig. 8].

As to claim 11, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches delivering the content to the client [S49 of fig. 8]; confirming that a URL pattern referenced in the licensing information corresponds to the URL address of the content [S47 of fig. 8]; and in response to confirming that the URL pattern corresponds to the URL addresses of the content, processing and rendering the content on the client [S49 of fig. 8].

As to claim 12, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the licensing information includes a licensing key [license ID, fig. 7].

As to claim 13, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the license key is an encrypted text file [0055-0060].

As to claim 14, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches overriding any other license key on the server when the license key is located through a root directory of the URL address of the content [0119-0123].

As to claim 15, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches determining whether the licensing information has been altered [S45 of fig. 8; 0093].

As to claim 16, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the licensing information further includes information pertaining to

restrictions on processing of the content [expiration date, attribute condition, usage rule [fig. 6-7-0091-0093].

As to claim 17, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the licensing information further includes information about a feature of the content that is enabled or disabled ["decrypt content and output content" if signatures of license and content are valid and "error processing" if signatures of license and content are invalid, s47-s50 of fig. 8].

As to claim 34, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that the communications handler or the licensing manager is associated with a runtime environment executing on a client system [0092].

As to claim 35, Ishii and Ishiguro teach the invention substantially as claimed. Ishii further teaches that a client system initiates the request to download the content from the server [fig. 3].

As to claims 24-32, 34, 35 and 39-44, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

Allowable Subject Matter

5. Claims 2-5, 18, 20-23 and 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 2, 20 and 36 the limitation of determining a URL pattern referenced in the licensing information and comparing the URL pattern referenced in the licensing information with the content URL address, taken together with other limitations of claims 1, 19 and 33 was not disclosed by the prior art of record.

Claims 3-5, 18, 21-23, 37, 38 being further limiting to claims 1, 19 and 33 are also objected to.

Response to Arguments

6. Applicant's arguments filed February 28, 2008 have been fully considered but they are not persuasive.

Applicant argues that neither Ishii nor Gordon teaches or suggest using the licensing address to access the licensing information at the licensing information location.

Examiner respectfully disagrees. Examiner believes that these features are taught by Ishii and Gordon. Ishii teaches that when the user selects the license ID of the selected license to the content server via Internet. The content server can extract the content to which the corresponding license ID as the key. Subsequently, the license server provides the client the content ID and URL address for downloading the content [see 0115-0116]. Examiner also believes that the feature of verifying the digital license of content taught by Ishii does constitute the feature of examining the licensing information of the content in the Applicant's claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy N. Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy N. Pardo/
Primary Examiner, Art Unit 2168